



THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

ZWW AF

Appeal No: Unassigned

In re application of: **SUZUKI, Yoshihisa et al.**

Group Art Unit: **2653**

Serial Number: **09/964,874**

Examiner: **Aristotelis M. PSITOS**

Filed: **September 28, 2001**

Confirmation No.: **1462**

For: **OPTICAL DISK DRIVE RESPONSIVE TO INTERNAL
TEMPERATURE CHANGE**

Customer Number: **38834**

Attorney Docket No.: **011299**

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 26, 2005

Sir:

The Examiner's Answer mailed March 29, 2005 presents comments not earlier developed by the Examiner during prosecution. Accordingly, appellants respond herein, even though appellants believe that the Appeal Brief generally presents arguments sufficient to justify the withdrawal of the appealed rejection.

As a preliminary matter, appellants note that the PTO changed its requirements for the format of Appeal Briefs on September 13, 2004. The Appeal Brief, which appellants filed December 20, 2004, conforms to the new requirements. For example, appellants do not provide statements of the "Issues" and "Grouping of Claims" as previously required. Therefore, it is not appropriate for the Examiner to write on page 2, top, of his answer that the Appeal Brief contains statements of the issues and grouping of claims. The Appeal Brief does not contain such

statements. Also, the Examiner refers to 37 C.F.R. § 1.192, but that provision is now removed (effective September 13, 2004).

Regarding the arguments in the Examiner's Answer specifically addressing the rejections, the Examiner's basic response is to cite large portions of text in the prior art references and then insist that the cited disclosures render the claims unpatentable. In some cases, the Examiner wrongly alleges that the subject matter is inherent. Appellants cite examples below while commenting specifically on the individual rejections.

Regarding the rejection of claim 24 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over *Otsuka* (JP 10-283645) or *Tsuchimochi* (JP 08-306052),¹ further considered with *Ogata* (JP 2000-236188)

Although worded differently, the Final Office Action indicates on page 3 that claim 24 is rejected on these four alternative grounds:

1. Under 35 U.S.C. § 102(e) as anticipated by *Otsuka* further considered with *Ogata*;
2. Under 35 U.S.C. § 102(e) as anticipated by *Tsuchimochi* further considered with *Ogata*;
3. Under 35 U.S.C. § 103(a) as obvious over *Otsuka* further considered with *Ogata*; and
4. Under 35 U.S.C. § 103(a) as obvious over *Tsuchimochi* further considered with *Ogata*.

In the Appeal Brief, appellants argue why each ground of rejection is untenable.

¹ As discussed in the Appeal Brief, the Final Office Action does not explicitly indicate that the prior art includes *Otsuka* and *Tsuchimochi*. Instead, the Final Office Action recites "the art as relied upon above with respect to claim 1" (which was canceled before the date the Office Action). An earlier Office Action indicates that *Otsuka* and *Tsuchimochi* were asserted against claim 1.

In response, the Examiner indicates on page 2 of the Examiner's Answer that claim 24 is rejected under 35 U.S.C. § 102(e) as anticipated by *Otsuka*. Although this ground of rejection resembles the first ground listed above, it is not the same rejection, because it is not based on also on *Ogata*. In fact, the recent ground of rejection differs from all four of the appealed grounds. That is, the Examiner has issued a new ground of rejection without official indication.

Accordingly, appellants explain as follows why the new rejection also is not proper.

Recall that appellants argued in the Appeal Brief, page 7, that:

Claim 24 describes an optical disk drive that has a "controller," and the claim specifies that the controller:

sets a focus offset value and/or tracking offset value at startup of the optical disk drive ... and resets the focus offset value and/or the tracking offset value when ...

That is, to justify the rejection of claim 24, the Examiner would at least need to show how the applied prior art teaches or suggests a controller that sets and later resets a "focus offset value" or a "tracking offset value" as specified in the claim.

However, the Examiner does not provide this showing. Specifically, the Examiner does not identify *any* disclosure of a "focus offset value" or a "tracking offset value" in the prior art, so he certainly does not indicate how the prior art supposedly teaches or suggests setting and resetting either value in the manner described in the claim. ...

The Examiner does not respond in his answer by identifying a "focus offset value" or a "tracking offset value" in the prior art and then indicating how the prior art supposedly teaches (or at least suggests) setting and resetting either value in the manner described in the claim. Instead, the Examiner merely cites paragraphs [0023] – [0033] of *Otsuka* and states that element 15 anticipates the claimed "controller." (Examiner's Answer, pages 3-4.)

Generally, if an applicant specifically argues that certain claim features are not taught by an applied reference, an Examiner cannot justify maintaining an art rejection without explaining how the reference supposedly teaches the claimed subject matter. Appellants reference *Ex parte Yamanaka et al.*, Appeal No. 2003-0121 (not binding precedent)² as pertinent. In reversing an examiner's rejection, the panel of the Board wrote that the Examiner did not adequately indicate how the asserted prior art supposedly rendered the rejected claims unpatentable. Note, for example, on page 8, "Yet, even though specifically argued by appellants, the examiner has made no effort to explain where this [a claim feature] is taught by the applied references."

As mentioned, in the present appeal, the Examiner only cites eleven paragraphs (of a machine assisted translation) and an element 15 as his response to appellants' specific citation of claim features as absent from the applied prior art. Accordingly, the Examiner's response is insufficient to justify his rejection.

Regarding the rejection of claims 10 and 11 under 35 U.S.C. § 103(a) as obvious over Kulakowski et al. (U.S. Patent No. 5,566,077) further considered with either Tsutsui (U.S. Patent No. 5,699,333) or Tsuchimochi

Applicants explain as follows in the Appeal Brief, pages 8-9, that the rejection of claims 10 and 11 should be reversed:

Claim 10 describes an optical disk drive that includes:

resetting means for resetting the focus offset value and/or the tracking offset value set by the setting means when the determination means determines that the difference [between two specified temperatures] has exceeded the predetermined level.

² Although this opinion is not binding precedent, appellants submit that the precedent *on which this opinion is based* applies also to the present appeal.

Claim 11 depends from claim 10, so it also includes this feature by virtue of its dependency.

...
The Examiner does not indicate any *Kulakowski et al.* teachings of resetting a focus offset value and/or a tracking offset value as a reaction to varying operating temperatures. Further, although the rejection also relies on *Tsutsui* and *Tsuchimochi* as supposedly teaching “correcting/compensating for focus offset” during temperature variations, the Examiner provides no explanation of why such a reaction to temperature variations would be desirable in a system (i.e., the *Kulakowski et al.* system) that already reacts by inhibiting certain operations as summarized above. ...

Accordingly, for the Examiner to justify his rejection, he should at least show how the asserted prior art teaches or suggests the “resetting means” as claimed. The Examiner responds to the Appeal Brief by stating that the “resetting means” is inherent. (Examiner’s Answer, page 6.) However, this element cannot be inherent for the following reason:

The “resetting means” resets a value when a difference between two specified temperatures has exceeded a predetermined level. The claims specify that the two temperatures are the internal temperature at startup and an internal temperature after startup. Surely, an optical disk drive can be configured so that its resetting means resets a value based on a different comparison of temperatures. For example, the recently measured temperature can be compared to a pre-established threshold, or an average of recently measured temperatures can be compared to the temperature at startup. Therefore, the comparison of an internal temperature at startup and an internal temperature after startup is not inherent, because alternative configurations are possible.

Also, the Examiner acknowledges appellants’ argument that “although the rejection also relies on *Tsutsui* and *Tsuchimochi* as supposedly teaching ‘correcting/compensating for focus

offset' during temperature variations, the Examiner provides no explanation of why such a reaction to temperature variations would be desirable in a system (i.e., the *Kulakowski et al.* system) that already reacts by inhibiting certain operations as summarized above." The Examiner provides his response in the final paragraph on page 7 of the Examiner's Answer. This response states generally that the prior art suggests the claimed invention, but there are no quoted teachings to support that conclusion.

Accordingly, the Examiner has still not properly explained why the reaction to temperature variations described in the claims would be desirable in the *Kulakowski et al.* system, which already addresses temperature variations in a different way. Thus, the Examiner has not justified his rejection.

With respect to claim 11, appellants argued on page 10 of the Appeal Brief that, because the Examiner has not explained how the asserted prior art teaches or suggests a determination means of an optical disk drive that determines whether the difference between a temperature most recently measured and an *immediately preceding* temperature has exceeded a predetermined level as claimed, the rejection of claim 11 should be reversed for at least this additional reason. The Examiner responds by generally citing three columns of text from one of the references as teaching the measurement of a temperature difference. (Examiner's Answer, page 8.)

A general measurement of a temperature difference does not anticipate the particular temperature difference described in claim 11. However, the Examiner writes that the cited prior art is sufficient to support his conclusion that the general teaching anticipates the particular feature claimed.

Thus, the Examiner has still not explained how the prior art teaches or suggests the determination of whether the difference between a temperature most recently measured and an *immediately preceding* temperature has exceeded a predetermined level. Accordingly, he has not justified his rejection of claim 11.

Regarding the rejection of claims 12, 13, 26, and 27 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kulakowski et al. in view of Takasugi (U.S. Patent No. 4,507,767) or Davis (U.S. Patent No. 5,276,697)

Appellants explain in the Appeal Brief, pages 11-13, why the rejection of claims 12, 13, 26, and 27 should be reversed. Specifically, the Examiner has not shown that the asserted prior art teaches or suggests resetting a laser output value when the difference between two specified temperatures exceeds a predetermined level.

In the Examiner's Answer, the Examiner provides two different responses: On page 10, he writes that this subject matter is inherent, and on page 11, he references the subject matter disclosed in *Kulakowski et al.*, column 6, lines 3-48. Appellants discuss above with respect to claims 10 and 11 why this claimed subject matter cannot be inherent. Regarding the cited text of *Kulakowski et al.*, to teach or suggest the quoted claim feature, this excerpt would at least have to discuss using the value of the internal temperature at startup to determine whether to reset a laser output value, and appellants find no such discussion. Certainly, the Examiner did not quote any such discussion.

With respect to claims 13 and 27, appellants argue on pages 13-14 of the Appeal Brief that, because the Examiner has not explained how the asserted prior art teaches or suggests a determining whether the difference between a temperature most recently measured and an

immediately preceding temperature has exceeded a predetermined level as claimed, the rejection of these claims should be reversed for at least this additional reason. The Examiner responds by generally citing large blocks of text from one of the references as disclosing this subject matter. (Examiner's Answer, page 13.)

As discussed above, citing *Ex parte Yamanaka et al.*, if an applicant specifically argues that certain claimed subject matter is not disclosed in the asserted prior art, an Examiner cannot justify maintaining an art rejection without explaining specifically where in the prior art how it supposedly discloses the claimed subject matter. A general citation of three columns of text is not adequate.

Thus, the Examiner has still not justified his rejection of claims 13 and 27.

Regarding the rejection of claim 25 under 35 U.S.C. § 103(a) as obvious over the prior art relied upon with respect to parent claim 24 (Otsuka, Tsuchimochi, and Ogata) and further in view of either Kulakowski et al. or Takagi (U.S. Patent No. 6,567,350)

Appellants explained in the Appeal Brief, pages 14-15, why the rejection of claim 25 should be reversed. Beside the fact that claim 25 depends from claim 24, which is not properly rejected, appellants argued that, because the Examiner has not explained how the asserted prior art teaches or suggests determining whether the difference between a temperature most recently measured and an *immediately preceding* temperature has exceeded a predetermined level as claimed, the rejection of claim 25 should be reversed for at least this additional reason.

The Examiner responds by generally citing large blocks of text from the prior art and stating that it supports his rejection. (Examiner's Answer, pages 13-15.) As discussed above, because the Examiner does not provide a more specific cite by quoting a particular prior art

teaching of the claim feature we identify in our argument, he has not properly responded to our argument.

* * *

In conclusion, appellants submit that the arguments presented above and in the Appeal Brief justify the reversal of all pending rejections.

In the event this paper is not timely filed, appellants petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Joseph L. Felber
Attorney for Appellants
Reg. No. 48,109

JLF/

Q:\2001\011299\011299 reply brief.doc